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10/596,878

03/05/2007

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20322 7590 04/30/2010  
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EXAMINER

LEE, LAURA MICHELLE

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

04/30/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/596,878 | <b>Applicant(s)</b><br>NISHIO, YOSHITAKA |  |
|                              | <b>Examiner</b><br>LAURA M. LEE      | <b>Art Unit</b><br>3724                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 4/16/2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8 is/are rejected.
- 7) ☒ Claim(s) 5-7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/16/2010 has been entered. Claims 1-8 are pending, claim 1 is amended.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Galindez (U.S. Patent 4,372,471). Galindez discloses a scribing line forming mechanism (Figure 9) comprising: a scribing line forming means (cutter wheel, 101) being structured so as to form a scribing line on a substrate by contacting the substrate, and the scribing line forming mechanism is configured to move on a surface of the substrate and to pull the scribing line forming means (101) to form the scribing line on the surface of the substrate along a movement path line (i.e. H) of the scribing line

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forming mechanism (as shown in Figure 12, the scribe line forming mechanism is manually pullable about path line H and thus pulls the cutter wheel) ; and a supporting means (cutter assembly, 105 / bearing housing 123) for supporting the scribing line forming means (wheel, 101) such that the scribing line forming means (101) is turnable about a first turning axis (defined by axis of cylindrical stub portion, 135), the supporting means (105/123) being structured so as to be turnable about a second turning axis (pivot point between arm T and arm S; Figure 12), the second turning axis (TS pivot) being different from the first turning axis (at 135), wherein the axial center of the first turning axis and the axial center of the second turning axis are approximately in parallel (both are vertical axis) and the axial center of the second turning axis (TS pivot) is distant by a predetermined interval (i.e. approx. by the length of arm S) from a portion where the substrate and the scribing line means forming means contact each other and the axial center of the second tuning axis is substantially perpendicular to a surface of the substrate.

It is noted that the limitation of "is distant by a predetermined interval" does not imply a constant or fixed interval. Applicant should also note that the limitations scribing line forming means are not in compliance with the Supplemental Guidelines published in the Official Gazette on July 25, 2000. Such limitations cannot be used to invoke 35 USC 112, 6th paragraph, and have therefore been given their broadest reasonable interpretation, without considering equivalence.

In regards to claim 2, Galindez discloses wherein the scribing line forming means includes a cutter wheel (101), and the supporting means (105/123) includes a cutter

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supporting means (105/102) for the cutting wheel (101) such that the cutter wheel is rotatable (at 102).

In regards to claim 3, Galindez discloses wherein the supporting means (105/123) includes a bearing (bearing, 108) for supporting the scribing line forming means (101).

In regards to claim 4, Galindez discloses a scribing line forming mechanism according to claim 1; and a pressure application means (i.e. piston 118/ fluid cylinder, 111) for applying a pressure force to the scribing line forming mechanism in order to press the scribing line forming means onto the substrate.

In regards to claim 8, Galindez discloses a moving means (motor, M and pneumatic cylinder) for moving the scribing head on a surface, the surface being approximately parallel to the substrate, such hat the scribing line forming means forms the scribing line of the substrate.

#### ***Allowable Subject Matter***

4. Claims 5-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach a scribing line forming mechanism with a scribe line forming means rotatable about a first axis parallel yet different from the axis of a supporting means that is further supported by a first supporting means rotatable about a

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third axis perpendicular (vertical) to the first two axes and also with a restriction means that restrains the turning of the first supporting means by contact.

### ***Response to Arguments***

5. Applicant's arguments filed 4/16/2010 have been fully considered but they are not persuasive. Applicant argues that Galindez does not disclose a scribe line forming mechanism that moves on a surface of the substrate and pulls the scribing line forming means to form the scribing line on the surface of the substrate along a movement path line of the scribing line forming means. However, the scribing line forming mechanism can be interpreted as all of the features shown in Figure 9 minus the support 124 and not upon the arms T,S, and pivot P as shown in Figure 12. Thus, as the scribing line forming mechanism is moved by arms T,S, and pivot P, the cutter wheel or scribe line forming means is pulled along the exact same path. When claim 1, second paragraph continues to describe the supporting means as being turnable about a first and second axis, the claims have not been set forth that both axis are axis that extend through the supporting means. Such that it can be construed that when the scribing line forming mechanism is attached to the arms T, S, and pivoted about point P, the supporting means is pivotable about a second axis (the axis between arms T, S, or alternatively P) without T,S, or P being considered a part of the scribe line forming mechanism. Alternatively, even if T,S, and P are considered part of the scribe line forming mechanism, then the scribe line forming means still travels along a movement path of the scribe line forming mechanism, the path defined by the movement of the

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mechanism as shown in Figure 9 minus the support 124. To overcome this interpretation, applicant is strongly suggested to amend the claims to better define the second turning axis of the support means relative to the supporting means, so that an external axis cannot read on the claim limitations.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAURA M. LEE whose telephone number is (571)272-8339. The examiner can normally be reached on Monday through Friday, 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Laura M Lee/  
Examiner, Art Unit 3724  
4/28/2010